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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/922,182	PLOW ET AL.	
	Examiner	Art Unit	
	MIN SHIN	3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 September 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6 and 13-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6 and 13-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the amendment filed on 9/2/2009. Claims 1-4, 6 and 13-19 are currently pending and have been considered below.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> **Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

Claims 14-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 14 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim recites in the preamble a computer program device, while the body recites a combination of means and logic means. However, it is unclear whether the claim pertains to a computer program product or a computer device, which is statutory, whereas "computer program device" in itself is not statutory under 35 USC 101 or does not pertain to a statutory class. Applicant can overcome the rejection by amending the claim as follows.

"Claim 14: A computer program product comprising:

a computer-readable medium bearing software instructions **to perform the steps of:**

storing at least one Internet advertisement

receiving plural Internet advertisements....

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 13-19 are rejected under 35 U.S.C. 112, second paragraph, as being confusing for failing to particularly point out and distinctly claim the subject matter, which applicant regards as the invention.

4. Claim 13 recites, in the body of the claim, "logic means." However, "logic" represents a module or software, whereas "means" represents structure. Thus, "logic means" has no apparent meaning in itself and thus, it is said to be confusing.

5.

6. Claim 14 recites, in the body of the claim, "logic means" or "computer readable medium means." However, "logic" represents a module or software, whereas "means" represents structure. Thus, "logic means" has no apparent meaning in itself and thus, it is said to be confusing. Further, "computer readable medium means" is confusing.

7.

8. Further, Claims 13-19 are a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function.

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claims 1-4, 6 and 13-19 rejected under 35 U.S.C. 102(a) as being anticipated by Rice (US 6,486,891).

Claim 1:

Rice discloses a method for storing internet advertisements at a user computer, comprising the acts of:

receiving internet advertisements at the user computer automatically without the user requesting them (column 5, lines 25-30 "At step 340, in response to the first type of ad selection, the **server causes the client to receive a web page associated with the advertisement, such as the home page of the advertiser, a particular promotional page from the advertiser's web site, or some other web page the advertiser chose to associate with the advertisement**");

executing software to automatically identify and save the advertisement at the user computer (column 2, lines 20-30 "**The Bookmark Banner also includes an area that causes the source of the advertisement to be bookmarked in the user's web browser**, for example. Subsequently, the user may view the source of the advertisement by selecting the previously created bookmark);

allowing a user to access saved advertisements in an advertising history window displaying Internet content composed of plural advertisements (Figures 5-6, column 6, lines 39-50" if the **user indicates he/she wishes to bookmark a web page associated with an advertisement, then the client sends a request to bookmark the web page** to the server) ;

allowing a user to filter previously displayed advertisements, so that only advertisements corresponding to one or more user selected attributes are eligible for display (column 6, lines 39-50);

recalling a user-selected saved advertisement from the saved advertisements, the recalled user-selected the saved advertisement having at least one link to a website (Figures 5-6 column 6, lines 39-50 "**Bookmarked Advertisement sites**"); and

accessing the website from the recalled-user-selected saved advertisement when the link is toggled (column 7, lines 1-20; "**the advertisement also supports automated bookmarking. If the user indicates he/she wishes to bookmark a web page associated with an advertisement, then the client sends a request to bookmark the web page to the server** (475).

Claim 2:

Rice discloses the method and system of claims 1 and further discloses wherein the advertisement includes a tag that is a Hypertext Markup Language (HTML) tag (column 3, lines 19-27)

Claim 3:

Rice discloses the method and system of claims 1 and further discloses comprising the act of: displaying a button; and in response to the button being toggled, displaying the saved advertisement (Figures 5-6 and Abstract)

Claim 4:

Rice discloses the method and system of claims 3 and further discloses wherein plural advertisements are saved and the method further comprises allowing the user scroll through the saved advertisements (Figure 5C, item 515).

Claim 6.

Rice discloses the method and system of claims 1 and further discloses comprising the acts of: displaying a previous button in the advertising window; displaying a next button in the advertising window; and accessing saved advertisements when the previous button and next button are toggled (Figure 5-6, column 7, lines 1-25).

Claim 13:

Rice discloses a system for saving at least one Internet advertisement at a user computer comprising:

at least one Web server; at least one database connected to the server, the database storing plural Interact advertisements (column 3, lines 1-25);

at least one user computer connected to the server via an Internet connection, the server transmitting the Interact advertisements to the user computer while the user is engaged in activity other than requesting the advertisements, the user computer including a program for saving at least one Interact advertisement, the program displaying plural saved advertisements simultaneously in an advertisement window such that a user may select a saved advertisement from the window for display on the user computer (Abstract; Figures 5-6; col 6, lines 5-39 "Additionally, the user is given the valuable **option of bookmarking a web page associated**

with the online advertisement thereby allowing the user to visit the advertiser's web site at a more convenient time. It is contemplated that in alternative embodiments, the online advertisements described herein may provide the ability to bookmark the advertiser's site without the accompanying ability to click-through to the advertiser's web site in a traditional fashion.");

logic means for enabling a user to select a saved advertisement for display thereof, the saved advertisement having at least one link to a website (col 6, lines 5-39);

logic means for accessing the website from the saved advertisement when the link is toggled;

logic means for displaying a previous button; logic means for displaying a next button; and logic means for accessing saved advertisements when the previous button and next button are toggled (Figures 5-6; column 8, lines 60-67; column 9, lines 1-6;).

Claim 14:

Rice discloses a computer program device, comprising:

a computer readable means having logic means for storing at least one Internet advertisement comprising:

logic means for receiving plural Internet advertisements at a user computer, the advertisements being sent to the user computer automatically in response to a user request for information other than the advertisements (column 8, lines 42-55;" **A second type of selection (e.g., a bookmark selection), causes a web page associated with the advertisement to be automatically bookmarked in the user's brow**sers.);;

logic means for saving the received advertisements at the user computer (column 8, lines 42-55);

means for allowing a user to select saved advertisements in an advertisement history window displaying Internet content composed only of advertisements (Figures 5-6; column 8, lines 60-67; column 9, lines 1-6; "In this example, the web page 600 also includes a tool bar having a file button 605, an edit button 610, and a bookmarks button 615. **As above, when the bookmark button is selected, a list of web pages that have been bookmarked are presented and the user may select one of the saved web pages to retrieve**);

means for enabling a user to recall at least one advertisement from the saved advertisement; and means for accessing the website from the saved advertisement when the advertisement is toggled (Abstract; Figures 5-6; column 8, lines 60-67; column 9, lines 1-6).

Claim 15:

Rice discloses the computer program device of Claim 14 and further discloses wherein an advertisement includes a Hypertext Markup Language (HTML) tag (column 3, lines 19-27)

Claim 16:

Rice discloses the computer program device of Claim 14 and further discloses:

logic means for displaying a button; and logic means for displaying the saved advertisement in response to the button being toggled (Figures 5-6 and Abstract).

Claim 17:

Rice discloses the computer program device of Claim 16 and further discloses wherein plural advertisements are saved and the computer readable means further comprises:

logic means for allowing the user scroll through the saved advertisements (Figure 5C, item 515).

Claim 18:

Rice discloses the computer program device of Claim 16 and further discloses wherein the saved advertisements include at least one link to a website and the computer readable means further comprises:

logic means for receiving plural Interact advertisements, at least one advertisement including a tag; and logic means for saving at least one advertisement at the user computer at least partially based on the tag (Figure 5-6).

Claim 19:

Rice discloses the computer program device of Claim 14 and further discloses wherein the computer readable means further comprises:

logic means for displaying a previous button;

logic means for displaying a next button;

and logic means for accessing saved advertisements when the previous button and next button are toggled (col 6, lines 5-39).

Response to Arguments

11. Claim 1: The Applicant argues in the response that Rice fails to disclose "executing software code to automatically identify and save the advertisements at the user computer." Examiner disagrees. Rice explicitly discloses wherein the *selection causes a web page associated with the advertisement to be automatically bookmarked in the user's browsers.* The applicant further argues the distinction that Rice saves the *address of the advertisement* rather the *advertising content.* However, it should be noted that saving the *address* or the link of the advertisement is equivalent to saving the advertising content. The address or the URL of the advertisement **is** an advertisement. Even the on-screen advertisement banner itself is only a link or address to a data of image or text that is stored at another place which are also link or address to bits of data at another place in a computer medium. In a computer environment, the data *pointing* or *addressing* another data is equivalent to the data (e.g. Pointers used in C++ programming language). Thus, there cannot be a distinction between saving the *content* of the advertisement and the *address URL* of the advertisement. Further, the present Claim 1 even recites **advertisement having at least one link to a website,** referring to the advertisement. Also, an URL of a site can be an advertisement. An advertisement in its broadest reasonable interpretation is any representation that promotes a product or service. It necessarily needs not be a graphical banner.

12. Claim 13: applicant further argues that Rice fails to disclose "allowing a user to access the saved advertisement in an advertising history window displaying Internet content composed of plural advertisement." First and foremost, the recited claim language carries very little patentable limitation. A method claim must be defined by specific *steps and process.* Simply *allowing* something to occur is not an explicit step, thus unclear (The user maybe "allowed" but

that does not mean that user performs the step). Further, Rice does disclose "*accessing the saved advertisements in an advertising history window"* through **Bookmarks** as disclosed in Figures 5 and 6 of Rice ("The user may view the source of the advertisement by selecting the previously created bookmark (column 2, lines 20-30). Applicant further argues that Rice fails to disclose "logic means for displaying a previous button, next button, accessing the saved advertisement button.." As discussed above, the only *logic means* associated with the limitations is a computer and a computer readable medium. Clarification as suggested above is recommended. Also, if the applicant is attempting to claim a "button" (e.g. a GUI), the claim should written in a manner that does not render itself as a printed matter (MPEP § 2106.01 and 706.03(a)A). This also applies to claim 14 as well.

13. Claim 14: Applicant argues that Rice fails to disclose "allowing a user to select saved advertisements in an advertisement history window displaying Internet content only of advertisement." As described above *allowing* something to occur is unclear. Further Rice discloses " when the bookmark button is selected, a list of web pages that have been bookmarked are presented and the user may select one of the saved web pages to retrieve" (Figures 5-6; column 8, lines 60-67; column 9, lines 1-6). Again, there is no distinction between saving the *advertisements* and saving the link or websites of the associated advertisements. The applicant further argues that Rice fails to disclose "enabling a user to recall at least one user-selected advertisement." Rice explicitly discloses accessing **Bookmarked** advertisements that were selected by the user (the user is given the valuable option **of bookmarking a web page associated with the online advertisement thereby allowing the user to visit the advertiser's web site** at a more convenient time; col 6, lines 5-39).

14. Applicant's arguments with respect to claim 1-4, 6 and 13-19 have been fully considered but they are not persuasive. However, due to new grounds of rejection regarding U.S.C 101 and 112 have not been addressed in prior actions, this Office Action is NOT made Final.

Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MIN SHIN whose telephone number is (571)270-3463. The examiner can normally be reached on Mon-Fri 9am-5pm.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weinhardt Robert can be reached on 571-272-6633. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MS
11/5/2009
/Jean Janvier/
Primary Examiner, Art